



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/874,042 | 06/06/2001 | Albert D. March | 11346-008 | 7614 |

7590 09/19/2006

Isis E. Caulder
Bereskin & Parr
Box 407
40 King Street West
Toronto, ON M5H 3Y2
CANADA

EXAMINER

LIVERSEDGE, JENNIFER L

ART UNIT PAPER NUMBER

3628

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/874,042 | MARCH, ALBERT D. | |
| | Examiner | Art Unit | |
| | Jennifer Liversedge | 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,9-16 and 18-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,9-16 and 18-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/874,042 filed on June 27, 2006.

The amendment contains original claims: 2-3, 9-12, 14-15, 19-23.

The amendment contains amended claims: 1, 6, 13, 16, 18, 24.

The amendment contains new claims: 25-29

Claims 4-5, 7-8, 17 have been canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 6, 9, 11, 14, 16, 18-21, 24 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,650,604 to Marcous et

Art Unit: 3628

al. (further referred to as Marcous), and further in view of U.S. Patent Number 6,105,009 to Cuervo (further referred to as Cuervo).

Regarding claim 1, Marcous discloses a financial transaction system for automated electronic transfer of funds (column 1, lines 7-12) comprising:

a receiving center configured for receiving a transfer request and a verification ID (column 2, lines 52-64; column 4, lines 11-16; column 8, lines 58-65) from a sender and for receiving a predetermined amount of funds (column 1, lines 24-46; column 3, lines 40-65) and further configured to provide access to the verification ID and amount of funds to a network of dispensing centers (column 10, lines 7-13); and

a dispensing center linked to said network of dispensing centers and configured for verifying the verification ID entered by a recipient (column 2, lines 52-64; column 4, lines 11-16; column 8, lines 58-65), receiving said amount of funds from said receiving center, and for dispensing said predetermined amount of funds to the recipient (column 2, lines 24-47; column 4, lines 16-30).

Marcous does not disclose a financial card. However, Cuervo discloses a financial card (column 2, lines 5-21). It would be obvious to one of ordinary skill in the art to combine the dispensing of debit cards as disclosed by Cuervo with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Art Unit: 3628

Regarding claim 2, Marcous discloses the financial transaction system further comprising an authorization center linked to said receiving center for authorizing the transfer (column 4, lines 11-25; column 8, lines 53-67; column 9, lines 1-57).

Regarding claim 3, Marcous discloses the financial transaction system wherein said authorization center is linked to said receiving center and said dispensing center over a communications network (column 3, lines 50-63; column 4, lines 42-64; column 5, lines 29-67, Figure 1).

Regarding claim 6, Marcous discloses the financial transaction system wherein the sender is coupled to said receiving center through a network (column 4, lines 30-64; column 10, lines 7-22).

Regarding claim 9, Marcous discloses the financial transaction system wherein said receiving center includes a financial card reader (column 3, lines 40-64; column 7, lines 49-55).

Regarding claim 14, Marcous discloses the financial transaction system wherein said receiving center further comprises a cash acceptance mechanism (column 3, lines 40-65).

Art Unit: 3628

Regarding claim 16, Marcous discloses a method for transferring funds (column 1, lines 7-12) comprising:

receiving from a sender at a receiving center a transfer request, a verification ID, and an amount of funds (column 1, lines 24-46; column 2, lines 52-64; column 3, lines 40-65; column 4, lines 11-16; column 8, lines 58-65; column 9, lines 12-20);

providing access to the verification ID and the amount of funds to a network of dispensing centers (column 2, lines 52-64; column 4, lines 11-16; column 8, lines 58-65; column 10, lines 7-13);

verifying the verification ID entered by a recipient at a dispensing center linked to said receiving center (column 2, lines 52-64; column 4, lines 11-16; column 8, lines 58-65);

receiving at the dispensing center the amount of funds from the receiving center (column 1, lines 24-46; column 2, lines 33-43; column 3, lines 41-65; column 10, lines 7-13).

Marcous does not disclose dispensing the amount of funds to the recipient via a financial card. However, Cuervo discloses dispensing the amount of funds to the recipient via a financial card (column 2, lines 5-21). It would be obvious to one of ordinary skill in the art to combine generating and dispensing debit cards as disclosed by Cuervo with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Regarding claim 18, Marcous discloses the method further comprising receiving information from said sender specifying the location for dispensing the amount of funds (column 1, lines 38-46).

Regarding claim 19, Marcous discloses the method further comprising the step of allowing the recipient to provide a verification PIN number to secure (said financial card) (column 4, lines 11-30).

Regarding claim 20, Marcous discloses the method further comprising the step of dispensing (said financial card) to the recipient through an ATM (column 2, lines 44-52; column 3, line 40 – column 4, line 30).

Regarding claims 11 and 21, Marcous does not disclose the financial transaction system wherein said financial card is a debit card. However, Cuervo discloses the financial transaction system wherein said financial card is a debit card (column 2, lines 5-21). It would be obvious to one of ordinary skill in the art to combine the dispensing of debit cards as disclosed by Cuervo with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Art Unit: 3628

Regarding claim 24, Marcous discloses a financial transaction system for automated electronic transfer of funds (column 1, lines 7-12) comprising:

means for receiving a transfer request and a verification ID (column 2, lines 52-64; column 4, lines 11-16; column 8, lines 58-65) from a sender and for receiving a predetermined amount of funds (column 1, lines 24-46; column 3, lines 40-65);

means for providing access to the verification ID and the amount of funds to a network (column 2, lines 52-64; column 4, lines 11-16; column 8, lines 58-65; column 10, lines 7-13);

means for verifying the verification ID entered by a recipient (column 2, lines 52-64; column 4, lines 11-16; column 8, lines 58-65), for receiving the amount of funds from the means for receiving (column 1, lines 24-46; column 2, lines 33-43; column 3, lines 41-65; column 10, lines 7-13), and for dispensing said predetermined amount of funds to the recipient (column 2, lines 24-47; column 4, lines 16-30).

Marcous does not disclose a financial card. However, Cuervo discloses a financial card (column 2, lines 5-21). It would be obvious to one of ordinary skill in the art to combine the dispensing of debit cards as disclosed by Cuervo with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Regarding claims 26 and 28, Marcous does not disclose the method wherein said predetermined amount of funds is dispensed to the recipient in a new financial

Art Unit: 3628

card. However, Cuervo discloses the method wherein said predetermined amount of funds is dispensed to the recipient in a new financial card (column 2, lines 5-21). It would be obvious to one of ordinary skill in the art to combine the dispensing of new financial cards as disclosed by Cuervo with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Regarding claims 27 and 29, Marcous does not specifically disclose the method wherein said predetermined amount of funds is dispensed to the recipient by recharging an existing financial card. However, Examiner takes Official Notice that the charging of existing financial cards is old and well known. It would be obvious to one of ordinary skill in the art at the time of the invention to use a financial transfer system in which an existing card is used to receive said funds, the motivation being to use old and well known technology. It is the scope of the Marcous invention as disclosed to provide an improved system in which the traditional use of an existing card is not required.

Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous and Cuervo as applied to claims 1 and 16 above, and further in view of U.S. Patent No. 6,636,833 B1 to Flitcroft et al. (further referred to as Flitcroft). Neither Marcous nor Cuervo disclose the financial transaction system wherein said financial card is a credit card. However, Flitcroft discloses the financial transaction system

Art Unit: 3628

wherein said financial card is a credit card (column 18, lines 18-24). It would be obvious to one of ordinary skill in the art to combine the dispensing of credit cards as disclosed by Flitcroft with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous and Cuervo. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Claims 12 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous and Cuervo as applied to claims 1 and 16 above, and further in view of U.S. Patent No. 6,048,271 to Barcelou (further referred to as Barcelou). Neither Marcous nor Cuervo disclose the financial transaction system wherein said financial card is a smart card. However, Barcelou discloses the financial transaction system wherein said financial card is a smart card (column 7, lines 52-62). It would be obvious to one of ordinary skill in the art to combine the dispensing of smart cards as disclosed by Barcelou with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous and Cuervo. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Claims 13 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous and Cuervo as applied to claims 1 and 16 above, and further in view of U.S. Patent No. 6,298,336 B1 to Davis et al. (further referred to as Davis). Neither

Art Unit: 3628

Marcous nor Cuervo disclose the financial transaction system wherein said financial card is a stored value card. However, Davis discloses the financial transaction system wherein said financial card is a stored value card (column 5, lines 12-18). It would be obvious to one of ordinary skill in the art to combine the dispensing of smart cards as disclosed by Davis with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous and Cuervo. The motivation would be to provide a variety of monetary mechanisms by which to transfer and receive funds in cash equivalent forms.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marcous and Cuervo as applied to claim 1 above, and further in view of U.S. Patent No. 5,861,841 to Gildea et al. (further referred to as Gildea). Neither Marcous nor Cuervo disclose the financial transaction system wherein said financial card contains a GPS receiver. However, Gildea discloses the financial transaction system wherein said financial card contains a GPS receiver (column 1, lines 10-28). It would be obvious to one of ordinary skill in the art to combine the inclusion of a GPS device in the financial card as disclosed by Gildea with the EFT/ATM system dispensing cash and cash equivalents (column 2, lines 33-38) as disclosed by Marcous and Cuervo. The motivation would be to enable the location of the financial card and it's user for currency exchange and tracking of one's safety purposes.

Response to Arguments

Applicant's arguments filed June 27, 2006 have been fully considered but they are not persuasive. Applicant sets forth three primary arguments.

First, Applicant argues that the references do not teach "receiving from a sender...an amount of funds" and "receiving at the dispensing center the amount of funds from the receiving center" in such a way as "no account is needed for either the sender or the receiver because the funds are transferred immediately...". However, Examiner cites Marcous in which funds are received by various means by a sender, and whereby the funds are then available at the receiving center for dispensing. Marcous discussed both methods such as Western Union in which funds are delivered electronically or by hand and subsequently wired to a receiver (column 1, lines 24-46), where an EFT is initiated by hand delivering funds (column 3, lines 63-67), as well as EFT means by which a sender electronically makes funds available and then those funds are available, without delay, at a receiving and dispensing center (column 3, lines 40-63). Marcous further discloses where neither the sender nor the receiver are required to maintain any accounts in order to engage in such transfers (column 2, lines 24-28; column 3, lines 63-67; column 8, lines 11-14).

Second, Applicant argues the receiving of funds onto existing and new financial cards. Cuervo discloses the issuing of new financial cards (column 2, lines 5-21). If the objective is to offer a means by which an individual in, for example, an emergency situation needs to be able to receive funds from a machine such as an ATM machine, the user would need the flexibility to receive the funds in formats such as cash, or on a

Art Unit: 3628

card issued by the machine. Thus, Marcous discloses the dispensing of cash (column 2, lines 33-51) and Cuervo discloses the issuing of new cards (column 2, lines 5-21). Regarding existing financial cards, it is the scope of the Marcous invention as disclosed to provide an improved system in which the traditional use of an existing card is not required (column 2, lines 48-51; column 3, lines 1-3; column 4, lines 2-5; column 8, lines 13-17). Using an existing financial cards to receive financial means is old and well known but less than useful if an individual is trying to receive funds, perhaps in an emergency, and does not have a or the proper financial card. Thus Marcous offers an improved system in which the baseline known system of using an existing card is improved upon to allow access to funds without the old and well known existing card.

Thirdly, Applicant argues that Marcous does not disclose wherein the sender specifies the location of the funds to be dispensed. Again, Examiner points to the section in Marcous in which Western Union is discussed and in which a receiver is required to go to a specific location as directed by the sender in order to receive transferred funds (column 1, lines 25-46). Marcous is improving this old and well known system through the use of ATMs and networks such that a user has additional flexibility to acquire funds. However, specifying the location to which funds are transferred is an old and well known practice such as to a Western Union office or to a recipients bank, etc.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

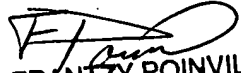
Art Unit: 3628

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

Art Unit 3628


FRANTZY POINVIL
PRIMARY EXAMINER
Acc 3628